

REMARKS / ARGUMENTS

These remarks are made in response to the Office Action of May 5, 2004. As this response is filed within the three-month shortened statutory period for reply, no fee is believed due.

Claims 1-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0076025 to Liversidge, *et al.* (Liversidge). To overcome Liversidge, the Applicants have submitted affidavits under 37 C.F.R. § 1.131, which were deemed insufficient by the Examiner in terms of demonstrating conception.

The Patent Office rejected Applicants affidavit under 37 C.F.R. § 1.131 as allegedly failing to show due diligence by Applicants from the date of the invention disclosure and as allegedly failing to support Applicants' claimed invention. This rejection is respectfully traversed.

Applicants resubmit herewith the affidavit under 37 C.F.R. § 1.131 showing the Applicants' date of invention predates Liversidge. The affidavit is accompanied by a copy of the Applicants' confidential invention disclosure entitled "E-mail Client with 'Set-Up a Voice Conference' Feature". Additionally, Applicants submit an affidavit signed by an individual familiar with the practices used by the assignee of the present application, IBM Corporation, that provides additional details showing that Applicants exercised due diligence from the date of the invention disclosure to the date the present application was filed. This affidavit also provides factual support showing that the subject matter set forth in the invention disclosure supports Applicants' claimed invention.

As set forth more specifically in the affidavit, the invention disclosure was created by the inventors on June 7, 2000. As set forth in the accompanying affidavit, once an invention disclosure has been created, it cannot be further amended by the inventors. As such, the invention is "complete" and, accordingly, supports the invention that is claimed.

More specifically, and in regards to the independent claims, the invention disclosure describes one embodiment of an e-mail communication method and message (page 1, paragraph 1) including the steps of inserting in an e-mail message a voice conference identifier comprising a voice conference call list identifying conference call nodes; transmitting said e-mail message to

a recipient at a recipient node, wherein responsive to said recipient selecting said voice conference identifier, a voice conference call between selected ones of said identified conference call nodes is established (see page 1, wherein the use of a symbol or icon that may be clicked to initiate a conference among the emails sender, receiver and others in the list is described).

Accordingly, as the invention disclosure is complete at the time of creation and as the invention disclosure describes the invention as claimed, Applicants' respectfully submit that the invention disclosure supports Applicants' claimed invention.

In regards to the Examiner's previous comments regarding page 2, paragraph 4 of the disclosure, it is respectfully submitted that this sections does not support the position that the invention was not conceived as of the date of the disclosure. Again, as set forth, the invention disclosure is considered to be complete as of the day it is created. Paragraph 4 simply determines whether a prototype or product has been prepared that implements the invention. In this instance, no product or prototype had been developed. As Applicants are unaware of any requirement that a prototype or product be shown to support a claim of conception, Applicants respectfully submit that conception of the invention occurred at least as early as June 7, 2000.

In regards to diligence, as set forth in the affidavit, once an invention disclosure is completed, the disclosure is reviewed by an invention review board in regards to whether or not to prepare an application on the submitted invention. As shown in the affidavit, the invention disclosure was approved and outside counsel were instructed to prepare the application on October 2, 2000, and still prior to the December 18, 2000 filing date of Liversidge. The application was then prepared and reviewed by the inventors, with this process taking multiple drafts prior to filing of the application. Accordingly, it is respectfully submitted that Applicants exercised due diligence from the date the invention was conceived to the date the application was filed.

Therefore, as the invention disclosure fully supports Applicants' claimed invention and as Applicants exercised due diligence from at least as early as June 7, 2000 until July 19, 2001, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection with respect to claims 1-37.

U.S. Patent Appln. No. 09/910,271
Response dated August 5, 2004
Office Action dated May 5, 2004
Docket No. BOC9-2000-0060 (195)

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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